

REMARKS

The examiner has withdrawn claims 2-24 and 26-29 from consideration on the grounds that the technical feature which links the inventions of groups I-XI does not constitute a special technical feature which defines a contribution over the prior art. In this regard the examiner has relied upon the teaching of Pier to support her position concerning the lack of a special technical feature which defines the contribution over the prior art and to support her rejection of claims 1 and 25 under 35 U.S.C. § 102(b). In particular the examiner urges that Pier teaches an adhesin protein from a strain among staphylococcus epidermidis which inherently has the fibrinogen binding activity.

Applicant submits that the examiner's decision to withdraw claims 2-24 and 26-29 from consideration should be rescinded because:

- a. the examiner's observation concerning the teaching of Pier is incorrect and thus the claims do in fact constitute a special technical feature which defines a contribution over the prior art;
and
- b. the examiner indicates that the inventions have already been prosecuted on the merits.

Pier teaches a purified capsular polysaccharide adhesin, not a purified adhesin protein or polypeptide. In particular Pier describes a method for purifying an adhesin of polysaccharide nature from cells of S. epidermidis. In this purification method the sample is treated with various enzymes to digest different unwanted substances like DNA, RNA and **proteins** (cf. column 7 isolation of adhesin and example 1, column 10). The actual use of pronase to digest any contaminating proteins is clearly very efficient since after the treatment, the purified adhesin is claimed by the inventor as being composed of carbohydrate with only low to non-detectable levels of protein (see

example III, column 11).

In view of the above, it is clear that the examiner's statement that Pier teaches a purified adhesin protein from a strain among *S. epidermidis* is clearly not correct. Furthermore, the examiner alleges that the adhesin described in the '455 patent inherently has the fibrinogen binding activity. In this regard applicant submits that the fibrinogen binding activity of the polysaccharide adhesin is never tested, mentioned, discussed or claimed by Pier. Thus the examiner's statement that the polysaccharide adhesin is fibrinogen binding has absolutely no relevance. In short, the invention described by Pier is an invention of **polysaccharide** nature completely different from applicant's invention which is a well defined **protein** with specified fibrinogen binding properties.

Clearly, the examiner should not withdraw claims 2-24 and 26-29 from consideration since the special technical feature which links the claims defines a contribution over the prior art. Furthermore, since the examiner has indicated that the originally filed claims have been prosecuted on their merits, there is absolutely no reason for withdrawing any of these claims from consideration.

In view of the above discussed distinguishing characteristics between the claimed invention and the cited reference, it is clear that the rejection of claims 1 and 25 under 35 U.S.C. § 102(b) is untenable and must be withdrawn.

The examiner has rejected claims 1 and 25 under 35 U.S.C. § 101 because the invention is directed to non-statutory subject matter. The examine suggests that this rejection can be overcome by further reciting that the protein or polypeptide of claim 1 is purified. Accordingly, claim 1 has been amended in this manner. In this regard it is to be noted that this limitation is also contained in claim 25 since claim 25 depends

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from claim 1 and thereby necessarily includes all of the limitations recited therein.

Lastly, the examiner notes in item 4 on page 3 of the office action that the application does not comply with the nucleotide and/or amino acid sequence requirements for the reasons noted in the "Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" which the examiner indicates as being included with the office action. The undersigned attorney informed the examiner that contrary to the examiner's statement, the office action did not include the aforementioned notice. The examiner therefore informed the below signed attorney that amending the claims and specification to refer to the appropriate sequence ID number for each of the sequences described in the specification and claims is sufficient to comply with the sequence rules. Accordingly, applicant has amended the application so that it is now in compliance with the sequence rules.

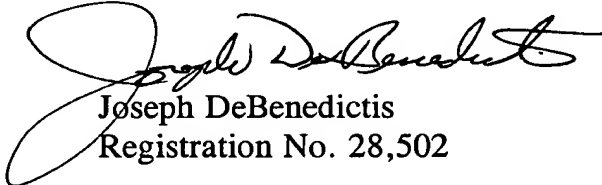
In view of the above arguments and further amendment to the claims, applicant respectfully requests reconsideration and allowance of all the claims which are currently pending in the application.

Respectfully submitted,

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